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| 10/042,591      | 01/09/2002  | Jeffrey S. Zehner    | 043210-1391-00      | 6630             |

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10/16/2003

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EXAMINER

CHIN, RANDALL E

3

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/042,591

Applicant(s)

ZEHNER ET AL.

Examiner

Randall Chin

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 21, 22 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 4 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other:

**Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-10 and 21-27, drawn to an apparatus for cleaning, classified in Class 15, subclass .

Group II: Claims 11-14, drawn to method for cleaning a paint spray gun, classified in Class 134, subclass 6.

Group II: Claims 15-20, drawn to a paint spraying system for electronically controlled painting, classified in Class 134, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and process for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as without a motor or a signal generator or the apparatus as claimed can be used to practice another and materially different process such as such as coating rods or objects.

Inventions (I, II) and III are different invention since Group III, Claims 15-20 requires an enclosure; a conveying apparatus; a manipulator which is not required by the inventions I and II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Mr. Glen Weitzer 948337) on May 27, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10 and 21-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

### **Joint Inventors**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

***Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed T. Chaudhry whose telephone number is (703) 308-3319. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:00 P.M.***

***If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gulakowski Randy, can be reached on (703)-308-4333. The fax phone number for this Group is (703)-305-7719.***

***When filing a FAX in Gp 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are for entry into the file of the application. This will expedite processing of your papers.***

***Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.***

***Saeed T. Chaudhry***

***May 28, 2003***

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-10, 21, 22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain '909 in view Swords '027.

Great Britain '909 discloses with respect to claims 1, 3, 8, 10, 21 and 26 an apparatus (see Fig. 3) for cleaning a spraying end (nozzle 7) of a paint sprayer 1, comprising a housing or solvent vessel 28 having an opening (at the top) and containing a solvent 29 at a solvent level, the opening configured to receive the spraying end of the paint sprayer 1, and a rotatable brush 30 having an exposed portion and only partially submerged (Fig. 3) in the solvent, the spraying end contacting the brush when the spraying end is inserted into the opening (see p.7, lines 15-17). Great Britain '909 discloses all of the recited subject matter with the exception of a motor operably interconnected with and operable to selectively rotate the brush and a limit switch or signal generator operable to provide an actuation signal that activates the motor thereby rotating the brush upon contact of the spraying end with the brush. Swords '027 teaches a rotary brush cleaning apparatus, comprising a motor 50 operably interconnected with and operable to selectively rotate a brush 62 and a switch or signal generator 110 operable to provide an actuation signal that activates the motor 50 thereby rotating the

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brush 62 upon contact of an implement 122 to be cleaned (at terminal 118 of switch 110) when inserted into housing opening 96 (see Figs. 3 and 4 and col. 3, lines 7-29). It would have been obvious to one of ordinary skill in the art to have provided the Great Britain '909 apparatus with a motor operably interconnected with and operable to selectively rotate the brush and a switch or signal generator operable to provide an actuation signal that activates the motor, thereby rotating the brush upon contact of the spraying end with the rotating brush as suggested by Swords '027 for the purpose of facilitating the cleaning operation by eliminating the use of any separate on-off switch to operate the motor.

As for claims 2 and 22, Great Britain '909 already discloses the brush 30 including a plurality of flexible bristles (Fig. 3), although not explicitly numbered.

As for claims 6, 7 and 25, Great Britain '909 already discloses the brush 30 being rotatable about a substantially horizontal brush axis, wherein the spraying end is insertable into the opening substantially perpendicularly to the brush axis (i.e., from the opening in the top of the vessel 28 in Fig. 3). Particularly with respect to claim 7, it is the Examiner's position that the brush axis could be below the solvent level if the vessel 28 is more than half full. Great Britain '909 does mention that the vessel is a reservoir for a supply of cleaning fluid (see col. 3, lines 9-12 and supply cap at upper left portion of vessel 28 in Fig. 3) and at least suggests that the vessel 28 could at least hold more fluid than shown in Fig. 3. In any case, the limitation in claim 7 calling for the brush axis to be below the solvent level is not deemed patentable for this reason.

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As for claims 9 and 27, Great Britain '909 already teaches the vessel 28 having a top wall wherein the opening (covered by valve 32 in Fig. 3) is smaller than the top wall.

3. Claims 5 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain '909 in view of Swords '027 as applied to claims 1 and 21 above, and further in view of Blackwell '572.

Blackwell '572 teaches a rotatable brush arrangement which can be driven by a pneumatic motor (see col. 3, lines 5-8). Blackwell '572 also teaches that the motor could be either a pneumatic, hydraulic or electrical motor. It would have been obvious to one of ordinary skill in the art to have provided the modified Great Britain '909 apparatus with a pneumatic motor as suggested by Blackwell '572 since the use of hydraulic, pneumatic or electrical motors are well known and the selection of the specific type merely depends on specific application and/or economics.

#### ***Allowable Subject Matter***

4. Claims 4 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Gerber, Jensen, Wheeler, Lupo, Nye, Jr., and Frecska are pertinent to various rotatable brush arrangements.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on (703) 308-2920. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



R. Chin

Randall Chin  
Primary Examiner  
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